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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/829,393
Filing Date: April 10, 2001
Appellant(s): MCHENRY ET AL.

MAILED

AUG 24 2007

GROUP 3600

Stephen L. Hensley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 18, 2007, appealing from the Office action mailed August 14, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,954,273	DENIS et al.	09-1990
6,182,048	OSBORN et al.	01-2001

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4,230,502 LUSTIG et al. 10-1980

4,303,597 KAY et al. 12-1981

ANON., "Ford Issues Winter Car Care Alert," PR Newswire, January 8, 1988.

Wilkinson, T., "Understanding What's in Your Car's Motor Oil," Consumers' Research Magazine, Vol. 25, No. 8, p. 20, August 1992.

Klepaki, L., "Reflect to Mirror Users," Women's Wear Daily, Vol. 178, No. 99 (November 19, 1999), p. 10.

Anon., "Drive Green Tips," PR Newswire, April 10, 1990.

McHenry et al., the instant application, page 2, lines 13-24.

Levine, J., "The Ultimate Sell" (Abstract), Forbes, Vol. 147, No. 10 (May 13, 1991), pages 108 and 110.

Marti, M.E., "Phyto-Active Chemicals" (Abstract), Drug & Cosmetic Industry, Vol. 150, No. 2 (February 1992), pp. 36 and 41-46.

Anon., "PCN Shows how to Virtually Market and Deliver," Interactive Marketing News, July 5, 1996.

Zambiazi, R.C., "The Role of Endogenous Lipid Components on Vegetable Oil Stability" (Abstract), Dissertation Abstracts International, Volume 58/11-B, p. 5720 (1997).

Nash, S., "More Free PC's," PC Magazine, Vol. 30, No. 1, May 25, 1999.

Anon., "Netzero," The IPO Reporter, September 20, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-22 and 34

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "Ford Issues Car Care Alert," hereinafter "Ford," in view of Osborn et al. (U.S. Patent 6,182,048). As per claim 1, "Ford" discloses (c) providing a motor oil having recommended, or user desired enhancements (three paragraphs beginning from, "(4) Use the proper engine oil") based on (a) data including type information about the motor vehicle in which the engine oil is to be utilized sufficient to identify a user's requirements (ibid). "Ford" does not disclose analyzing the data by

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computer, but Osborn teaches analyzing motor vehicle related information by computer (column 3, line 27, through column 6, line 35). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to analyze the data by computer, and provide an engine oil responsive to the data analysis, for the obvious advantage of using a computer for calculations that may be difficult or time-consuming for human beings to perform, e.g., involving multivariate linear regression, as taught in Osborn, to provide a motor oil selected on the basis of numerous factors.

As per claim 2, "Ford" discloses basing a decision on type of vehicle, and selecting a lubricant as recommended based on the type of vehicle (three paragraphs beginning from, "(4) Use the proper engine oil").

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 above, and further in view of Wilkinson ("Understanding What's in Your Car's Motor Oil"). Osborn teaches computer analysis based on expected ambient temperatures (column 5, line 61, through column 6, line 35), and Wilkinson teaches that the advantages of a motor oil depend on ambient temperatures (paragraphs beginning "There are still some backyard chemists" and "The problem? Price."). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to practice (a) to input at least one of expected ambient temperatures, average driving distance, normal type of driving, and interest in fuel economy, cold weather starting, and engine longevity, for the obvious advantage of providing an engine oil suited to a particular user's needs.

Claims 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborne as applied to claim 1 above, and further in view of Klepacki ("Reflect to Mirror Users"). As per claim 4, the different engine oils in "Ford" can be regarded as customized for different circumstances of use, and it is well known to make custom blends of mixed materials, as taught, for example, by Klepacki (especially paragraph beginning, "Unlike most beauty e-commerce sites," and the paragraph thereafter; see also remainder of Klepacki article for obtaining input from users, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for (a)-(c) to be practiced to design, produce, and deliver or make available a customized engine oil, for the obvious advantage (analogous to the advantage achieved in Klepacki) of customizing the oil to best suit a particular user.

As per claim 5 (depending on claim 4), and **as per claim 6** (depending on claim 1), Klepacki teaches displaying a questionnaire on a computer screen connected to a global computer network and prompting a user to input information into the questionnaire (three paragraphs beginning from "The degree of customization to be offered"; the computer screen as such being implied by the Web-based questionnaire).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, and Klepacki as applied to claim 6 above, and further in view of official notice. "Ford" does not disclose displaying on the computer screen indicia indicating the ability of the user to order other automotive products, but official notice is taken that it is well known to display advertising indicia on computer screens. Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to display displaying on the computer screen indicia indicating the ability of the user to order other automotive products, for the obvious advantage of profiting from the sale of automotive products to persons likely to be interested in buying them.

Claims 8-12, 14, 15, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, and Klepacki as applied to claim 4 above, and further in view of Denis et al. (U.S. Patent 4,954,273). As per claims 8-12, "Ford" is not explicit about the composition of the lubes, but Denis teaches a customized motor oil containing about 86.24 percent of a baseline motor oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant, or a blend stability additive (Fully Formed Example III, column 13, lines 46-68). Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to provide a baseline motor oil of from about 50, 60, 75, or 80 percent to 99.9 percent of the final customized engine oil, and at least one of the listed additives, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

As per claim 14, Denis teaches providing an absolute increase of from about 0.1-10% in at least one selected from the group consisting of fuel economy additives, antiwear additives, detergent additives, dispersant additives, oxidation control additives, corrosion inhibitors, pour point depressants, and blend stability additives (Fully Formed Example III, column 13, lines 46-68). Hence, it would have been obvious to one of

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ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to add additives as listed, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

As per claim 15, Denis teaches providing additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability (Fully Formed Example III, column 13, lines 46-68). Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to add additives leading to at least two or more of the listed enhanced features, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

As per claim 16, likewise, Denis teaches adding additives leading to at least three of said enhanced features, making claim 16 obvious on the same grounds as claim 15.

As per claim 21, Denis does not expressly disclose that (c) is practiced to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, but does teach that "a basic nitrogen containing dispersant" can vary from 1 to 15 weight percent, and "a detergent in the form of an overbased calcium sulfonate" from 0.2 to 3 weight percent (General Formulated Example, column 13, lines 1-21). Hence, it

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would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to change at least one of detergent and dispersant concentration levels over the range from about -50% to about +200% compared to their concentration levels in a quality baseline motor oil, for the obvious advantage of producing a customized engine oil having desired properties.

As per claim 22, Denis discloses variations in both detergent and dispersant levels, as noted above in regard to claim 21.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, Klepacki, and Denis as applied to claims 8-12 above, and further in view of official notice. Neither "Ford" nor Denis discloses that (c) is practiced to provide about 0.1-100% percent improvement in at least one of fuel economy, wear performance, detergent performance, dispersant performance, oxidation protection, corrosion protection, low temperature performance and blend stability, but Denis does teach adding additives to improve these characteristics, as set forth above. The reasonable presumption is that one would not go to the trouble of attempting to determine optimal quantities of various additives, and the expense of adding these additives, as taught in Denis and other art of record, unless these additives produced a non-trivial improvement in the properties that they were intended to improve. Indeed, one would hardly identify a chemical as, for example, an antiwear additive unless its effects on preventing wear were detectable without extreme effort, implying an improvement greater than 0.1%. Official notice is taken that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100%

under some circumstances, a lower concentration would produce an improvement of less than 100% -- and, indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil. Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to provide about 0.1-100% improvement in at least one of the listed characteristics, as an obvious consequence of adding desirable additives as taught by Denis.

Claims 17, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford," Osborn, Klepacki, and Denis as applied to claims 15 and 16 above (to claim 15 in the case of claims 17 and 19; to claim 16 in the case of claims 18 and 20), and further in view of official notice. These claims are essentially parallel to claim 13, and rejected on essentially the same grounds.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Ford" and Osborn as applied to claim 1 above, and further in view of the admitted prior art. "Ford" does not disclose practicing steps (a) – (c) using formulation guidelines or computer models to maintain industry performance credentials of the customized engine oil, but the instant application teaches that there are accepted industry standard practices outlined in codes introduced by industry organizations such as the American Chemistry Council and the Technical Committee of Petroleum Additive Manufacturers in Europe (page 2, lines 13-24). Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (a) – (c) using formulation guidelines or computer models to maintain industry performance

credentials of the customized engine oil, for the obvious advantages of benefiting by the accumulated knowledge of the industry, and being able to cite compliance to standard performance credentials as a defense in the event of product liability suits.

Claims 23-32

Claims 23, 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepacki ("Reflect to Mirror Users") in view of Wilkinson ("Understanding What's in Your Car's Motor Oil"), the anonymous article, "Drive Green Tips," and official notice. As per claim 23, Klepacki discloses: obtaining a custom product by (a) using an implement to transmit information from a user to a customized blending facility; and (b) blending a custom product using the information from (a) (two paragraphs beginning from, "Unlike most beauty e-commerce sites," and three paragraphs beginning from, "The degree of customization to be offered"). Klepacki does not disclose that the information is information about a user's motor vehicle type, environment of use, and desired operational characteristics, but Wilkinson teaches selecting an engine oil based on environment of use (the two paragraphs beginning from "What Experts Recommend," and the two paragraphs from "There are still some backyard chemists"), and motor vehicle type (paragraph beginning "Ask any engine engineer at a car company"), while "Drive Green Tips" teaches a motor oil affecting desired operational characteristics (paragraph beginning, "If the Owner's Guide recommends"). Hence, it would have obvious to one of ordinary skill in the art of electronic at the time of applicant's invention to transmit this information, and to blend

an engine oil accordingly, for the obvious advantage of providing a suitable product in accordance with a user's particular needs.

Klepacki does not expressly disclose (c) delivering to, installing, or making available for pickup by a user the custom product from (b), but official notice is taken that it is well known for e-commerce websites to deliver or make available products ordered by users. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to deliver to, install, or make available for pickup by a user the custom engine oil, for the obvious advantage of giving a user reason to participate in the website, and pay for the ordered product.

As per claim 24, Klepacki discloses that (a) is practiced using a telephone, computer network, or prepared document; as per claim 25, Klepacki discloses that (a) is practiced using a global computer network; and as per claim 26, Klepacki discloses electronically displaying a questionnaire on a computer screen connected to a global computer network and prompting a user to input information into the questionnaire (three paragraphs beginning from "The degree of customization to be offered"; the computer screen as such being implied by the Web-based questionnaire).

Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepacki, Wilkinson, "Drive Green Tips," and official notice applied to claim 23 above, and further in view of Denis et al. (U.S. Patent 4,954,273). As per claim 27, neither Klepacki nor Wilkinson discloses that blending a custom engine oil is practiced to add additives leading to at least two or more enhanced features selected from enhanced wear protection, enhanced fuel economy, enhanced detergency, enhanced

dispersancy, enhanced low temperature startability, enhanced high temperature viscosity, extended drain capability, enhanced wear protection, corrosion protection, enhanced control of oxidation and enhanced blend stability, but Denis teaches adding additives to enhance two or more of these features (Fully Formed Example III, column 13, lines 46-68). Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (b) to add additives leading to at least two or more of the listed enhanced features, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

As per claim 28, likewise, Denis teaches adding additives to enhance three or more of the listed features (Fully Formed Example III, column 13, lines 46-68), making claim 28 obvious on the same grounds as claim 27.

As per claims 29-32, Denis teaches a customized motor oil containing about 86.24 percent of a baseline motor oil, and at least one of a fuel economy additive, an antiwear additive, a detergent additive, a dispersant additive, a corrosion inhibitor, an antioxidant, a pour point depressant, or a blend stability additive (Fully Formed Example III, column 13, lines 46-68). Hence, it would have been obvious to one of ordinary skill in the art of engine lubrication at the time of applicant's invention to practice (c) to provide a baseline motor oil of from about 50, 60, 75, or 80 percent to 99.9 percent of the final customized engine oil, and at least one of the listed additives, for the obvious advantages of producing increased fuel economy, reduced wear, etc.

(10) Response to Argument

There are proper grounds to consider Appellant's claims obvious, as will be set forth below. In particular, and to begin with, claim 1 is quite broad, and was properly rejected. Appellant argues that Examiner has failed to establish a *prima facie* case of obviousness, and cites criteria for establishing such a case. Examiner wishes to note, before even addressing the particular teachings, suggestions, or motivations applied to reject claim 1, that the Supreme Court has ruled, in *KSR Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007) that it is an "error to apply the TSM test as [a] rigid and mandatory formula that limits obviousness analysis through formalistic conception of words 'teaching,' 'suggestion,' and motivation," and also declared "rigid application of preventative rules that deny fact finders recourse to common sense are neither necessary nor consistent with precedent." (Pages 1385 and 1386.) *KSR* forecloses Appellant's argument that a specific teaching is required for a finding of obviousness; one may further note the Court's words at 1396: "The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real

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innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their utility or value."

Claim 1 in particular should be considered in light of the Supreme Court's ruling that fact finders should not be denied recourse to common sense, as it recites that the steps of the claim "are practiced to allow a customer to participate in the design, selection or customization of a particular motor oil to fit that customer's needs," which only requires one of the three, so that an existing motor oil can be selected, without a new motor oil being designed or customized. Thus, a customer might call the Ford Motor Company's advice number to ask what motor oil he should put in his car. The telephone receptionist who receives the call could ask what kind of car the customer owns, and, upon being told, input the answer into a computer that searches its database for appropriate information, and brings it up for the receptionist to read. In accordance with the teachings of the "Ford Issues Winter Car Care Alert" article, the receptionist might say, "5W-30 motor oil, sir. It should be available at your local gas station." Thus, all limitations of claim 1 might be met without any complicated mathematical analysis by the computer, and without any design or customization of motor oil, merely selection.

Appellant argues that "Ford" and Osborn fail to teach or suggest providing motor oil having user-desired characteristics for an individual consumer by analyzing information provided by the consumer. Examiner replies that computer analysis of data, as taught by Osborn, is well known, and hence would have been obvious to combine with the "Ford" article, for the advantage of using a computer to perform tedious calculations, or rapidly search through a database. Appellant argues that "Ford" lacks

all of the elements of claim 1. Examiner replies that while "Ford" lacks step (b), for which Osborn was relied upon, "Ford" teaches equivalents of (a) and (c), by showing how motor oils are recommended based on the type of vehicle engine involved. Putting the information taught in "Ford," and in the owner guides to which "Ford" refers, into a computer database from which recommendations for users could be obtained based on their vehicles and/or weather conditions – conditions mentioned in "Ford" as relevant to selecting a preferred motor oil – would essentially lead to the method of claim 1.

Appellant argues that the Osborn patent is irrelevant because it is not directed to motor oils. Examiner replies that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Osborn is reasonably pertinent to the problem with which the applicant was concerned, because it teaches computer analysis of data, which is well known and widely practiced, and further because it is concerned with motor vehicles, and with the effect of temperature and other climate conditions on their operations.

Regarding claim 3, Appellant argues that Wilkinson does not teach various features which Examiner never relied on it to teach, but rejected based on "Ford" and Osborn. Wilkinson teaches that the advantages of a motor oil depend on ambient temperatures, so that one would choose a type of oil in the frigid north which for most drivers would not be worth the higher price elsewhere. On this basis, it was held to be

obvious to input ambient temperatures; also, "Ford" teaches that a particular motor oil is advantageous at cold temperatures.

Regarding claim 6, Klepacki is relied upon to teach displaying a questionnaire on a computer screen connected to a global network, and prompting the user to input information into the questionnaire. In addition to reiterating previous arguments against the other prior art applied to claim 1, Appellant argues that Klepacki relates to cosmetics, skin care, and hair care products, rather than to motor oils. Examiner replies that Klepacki is nonetheless pertinent to the problem with which the applicant was concerned, namely gathering information about a particular customer's needs or wants so as to provide a customized product.

Regarding claim 7, Appellant disputes that it would have been obvious to display on the computer screen indicia indicating the ability of the user to order other automotive products, based on Examiner's official notice that it is well known to display advertising indicia on computer screens. It is beyond reasonable dispute that such displays are well known, but Appellant argues that "Ford" is merely a news article providing advice on winter car care, and that "Ford," Osborn, and Klepacki do not make obvious the claims on which claim 7 depends. Examiner notes that Osborn and Klepacki are concerned with computer screens, and Klepacki in particular with ordering customized goods via a computer network. If the preceding claims are obvious, it is hard to maintain that the well-known feature of claim 7 makes it patentable; if either of claims 1 or 6 be allowable, the question of claim 7 is moot.

Appellant presents arguments concerning claim 34, the remaining dependent of claim 1, further along in the Appeal Brief, on pages 27 and 28. Examiner relied upon the admitted prior art (instant application, page lines 13-24) to teach that there are accepted industry standard practices outlined in codes introduced by industry organizations such as the American Chemistry Council and the Technical Committee of Petroleum Additive Manufacturers in Europe. Appellant repeats his argument that "Ford" and Osborn do not make claim 1 obvious, to which Examiner replies that his arguments for obviousness should be taken as reiterated; furthermore, Appellant argues that the requisite motivation to combine references must come from the prior art, not applicant's specification. Examiner replies that this is not entirely the case, since, in addition to the recent *KSR* decision, already cited, it has long been a doctrine of patent law that some teaching, suggestion, or motivation to combine references must be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation based on generally available knowledge is cited, the obvious advantages of benefiting by the accumulated knowledge of the industry, and being able to cite compliance to standard performance credentials as a defense in the event of product liability suits. On this basis, one could reasonably expect the 5W-30 and other motor oils mentioned by "Ford" to be manufactured "using formulation guidelines or computer models to maintain industry performance credentials."

Claim 4 and its dependents present somewhat different issues, since claim 4, unlike claim 1, recites that steps (a)-(c) are practiced to design, produce, and deliver or make available a customized engine oil, not merely to select an existing motor oil available off the shelf. In addition to reiterating previous arguments, Appellant argues that Klepacki, which was relied upon in rejecting claims 4 and 5, relates to cosmetics, skin care, and hair care products, not to motor oils or automobiles. Examiner reiterates what he wrote with regard to claim 6, that Klepacki is nonetheless pertinent to the problem with which the applicant was concerned, namely gathering information about a particular customer's needs or wants so as to provide a customized product. Moreover, in response to Appellant's insistence that the motivation for combining references must come from the prior art, Examiner reiterates his references to the decisions in *Fine*, *Jones*, and *KSR*.

Regarding claims 8-12, 14, 15, 16, and 21, Appellant once again reiterates his arguments against the obviousness of customizing a motor oil, and also argues that Denis does not teach a customized motor oil tailored to the individual needs of a customer, but an over-based salt additive for crankcase oils. Examiner replies that Denis teaches preparing various oils by starting with a 10W-40 or 15W-40 base oil, and adding a number of different ingredients, such as a VI improver, a pour point depressant, an anti-wear agent, a dispersant, and an overbased magnesium salicylate, in addition to the calcium carboxylate which Denis refers to as his invention (e.g., column 13, lines 46-68). Furthermore, Denis does not merely teach one particular composition of a motor oil, but several alternative compositions, as set forth in the

"General Formulated Example" and four different "Fully Formulated Examples" in columns 13 and 14. Granted that Denis does not teach formulating these different oils in response to obtaining and inputting data from a particular user, and analyzing the data by computer, so as to allow the customer to participate in the design, selection, or customization of a particular motor oil, if one enables a customer to input data and participate in such design, selection, or customization, it would be obvious to customize the motor oil in accordance with the prior art in lubricant compositions, adding different additives as taught by Denis.

Appellant writes, "Denis merely describes a fully blended crankcase oil with a slate of additives. Appellants are not claiming the composition of a motor oil but a method of obtaining a customized motor oil to suit a specific customer's needs." Examiner replies that neither of these statements is entirely accurate. Denis describes preparing several fully blended crankcase oils by adding particular slates of additives to a base oil of a certain weight, and, while Appellant claims a method of customizing motor oil, the dependent claims do recite specific compositions of the customized motor oil. Whatever else may be said of the application, Examiner does not believe that one can plausibly maintain that a method of customizing motor oil is obvious, but becomes non-obvious if the customized motor oil has a composition within the range explicitly disclosed by a prior art patent.

Claim 13 recites that step (c), the step of providing a motor vehicle engine oil having recommended or user-desired enhancements, is practiced so as to provide about 0.1-100% improvement in at least one of a number of listed measures of

performance. Appellant disputes Examiner's statements of "common knowledge" or "well-known prior art," and Examiner's conclusion that it would have been obvious to provide about 0.1-100% improvement in at least one of the listed characteristics as a consequence of adding desirable additives as taught by Denis. Appellant also denies the relevance of the prior art which Examiner made of record with the Office Action mailed February 3, 2006, to support the taking of official notice that the effects of many additives are, within a range, dependent on concentration, so that, even if the improvement were over 100% under some circumstances, a lower concentration would produce an improvement of less than 100% -- and, indeed, it might be that no concentration of an additive would improve performance by more than 100% over a baseline oil. (Appellant slightly misquotes Examiner, since official notice was not taken that the effects of many motor oil additives are, within a range, dependent on concentration.) Appellant argues that Marti, Zambiazi, Lustig, and Kay, which were made of record in support of Examiner's official notice (see Appendix), do not relate specifically to additives to motor oil. Examiner replies that a teaching that specific is not required. The art cited to support official notice establishes that the effects of many additives are dependent on concentration, for different kinds of additives in different chemical mixtures. Thus, one of ordinary skill would presume that the effects of additives to motor oil depended on their concentration, even if he did not know precisely what the dependence relation was (it might be non-linear, as Lustig teaches).

In fact, it would be astonishing if the effects of additives to motor oil did not depend on their concentration. Based on the teaching of Denis, of adding "about 1.0

weight percent of anti-wear agent in the form of zinc dithiophosphates" to a motor oil, for example, one would not expect to be informed that 0.1 weight percent, or 0.0001 weight percent, worked equally well. In that case, why would Denis teach adding a full 1.0 weight percent?

Regarding motivation, Examiner replies that one scarcely needs a motivation to achieve an improvement falling within such a broad range; the trick would more likely be in avoiding it. An improvement in enhanced detergency or low temperature performance of less than 0.1% would likely be scarcely worth bothering with, and could be difficult to measure. An improvement exceeding 100% in one of these, or in such features as enhanced fuel economy or corrosion protection might be difficult to achieve. Appellant's specification, after all, recites customized motor oil selection, rather than a major breakthrough in lubricant chemistry enabling vehicles to go more than twice as far on a gallon of gasoline as was possible with earlier motor oils.

Claims 17-20 are closely similar in type to claim 13, reciting that the method is practiced to provide absolute increases in two, three, or more enhanced features of from 0.01-10% or 0.01-100%. The basic issues are essentially the same as those raised by claim 13, and once again, while the obviousness or non-obviousness of the claimed method of customizing a motor oil based on data input by a customer may be debatable, given such a method, achieving a particular improvement somewhere within a broad range is an obvious consequence of applying known techniques of adding various additives, as taught by Denis.

Appellant does not appear to explicitly address claim 22, which recites, "The method of claim 21, wherein both of said detergent and dispersant concentration levels are changed." Examiner rejected this on the ground that Denis discloses variations in both detergent and dispersant levels.

The final independent claim is claim 23, rejected with Klepacki as the primary reference; Wilkinson and the anonymous article "Drive Green Tips" are secondary references. Appellant does not fail to observe that Klepacki does not relate to motor oils at all, but relates to cosmetics and hair care products, such as shampoo, which are made to order, based on an individual's preferences. Examiner replies that while Klepacki does not disclose customizing motor oil, it does disclose obtaining a custom product by the equivalents of steps (a) and (b) of claim 23, while Wilkinson teaches selecting an engine oil based on environment of use, and "Drive Green Tips" teaches a motor oil affecting desired operational characteristics. There is therefore suggestion, teaching and motivation to transmit particular information about the user's motor vehicle type, environment of use, and desired operational characteristics to apply the method of Klepacki to blending a motor oil in particular. The prior art of record contributes to the motivation set forth in the rejection, and it is scarcely necessary to invoke *KSR* once again, in cautioning against too rigid an application of the TSM test.

Appellant further requests that Examiner produce authority for the statement that it is well known for e-commerce websites to deliver or make available products ordered by users. Examiner replies that he need not do so, for three reasons. First, Appellant

did not traverse Examiner's taking of official notice in a timely fashion. It was not done in the Remarks made in response to the rejection mailed February 3, 2006, where Examiner first rejected claim 23 based on Klepacki, and took official notice that it is well known for e-commerce websites to deliver or make available products ordered by users. Secondly, the traversal is not adequate, because Appellant does not state why the noticed fact is not considered to be well-known in the art. The Manual of Patent Examination Procedure (2144.03 (C)) states, in regard to traversal of Official Notice:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without reference to the examiner's assertion of official notice would be inadequate.

Thirdly, even without explicit teaching in Klepacki that the customized products are delivered to, installed, or made available for pickup by users, the step would have been obvious and implied based on Klepacki, because it would not make sense to

question the user on just what kind of shampoo she wanted, whether it should be lightly or heavily fragranced, whether it should come in a flip-top or pump bottle, custom-manufacture the shampoo or other product to order, and then not deliver the customized product, or make it available for pick-up. This would appear to be entirely irrational behavior on the part of the Reflect.com website described in Klepacki, and Klepacki discloses in the first paragraph that Reflect.com is a venture of Procter & Gamble, a major consumer products corporation which surely did not become and remain a major corporation by utterly irrational behavior.

Regarding claims 24, 25, and 26 Appellant once again reiterates his position that one skilled in the art at the time the invention was made would not have been motivated to combine, Klepacki, Wilkinson, "Drive Green Tips," and the common business practice of which official notice was taken to arrive at the claimed invention. Examiner replies that each of claims 24, 25, and 26 was rejected based on the teachings of Klepacki, without recourse to the teachings of the secondary references. If claim 23 is obvious, they are as well.

Claims 27-32 are rejected based on Klepacki, Wilkinson, "Drive Green Tips," and official notice as applied to claim 23, and further in view of Denis. As Appellant's arguments against the applicability of Denis to making the particular additives claimed obvious are essentially the same as those presented above with regard to claims 8-12, 14, 15, 16, and 21, Examiner reiterates his arguments from the discussion of those claims, above.

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Hence, Examiner maintains that a sound prima facie case has been made for rejecting the claims now pending.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Appendix to Examiner's Answer in Application 09/829,393

This is the response to traversal of official notice from the Office Action mailed February 3, 2006:

Response to Traversal of Official Notice

Applicant has traversed Examiner's taking of official notice in the previous Office Action. Some takings of official notice have been mooted by Examiner's reliance in the present Office Action on different prior art, expressly teaching elements of which official notice was taken previously. Regarding the remaining takings of official notice from the previous Office Action:

In rejecting claim 7, Examiner took official notice that it is well known to display advertising indicia on computer screens: This is supported by Levine ("The Ultimate Sell" Abstract); by the anonymous article, "PCN Shows how to Virtually Market and Deliver"); by Nash, "More Free PC's"; and by the anonymous article "Netzero."

In rejecting claim 13, Examiner took official notice that the effects of many additives are, within a range, dependent on concentration. This is supported by Marti ("Phyto-Active Cosmetics" Abstract); by Zambiazi ("Role of Endogenous Lipid Components on Vegetable Oil Stability" Abstract); by Lustig et al. (U.S. Patent 4,230,502), column 1, lines 1-25; and by Kay (U.S. Patent 4,303,597), column 6, lines 28-33.